

REMARKS

Claims 1-7 will be pending in the Application after the Examiner enters the forgoing amendment. Applicant respectfully submits that the pending claims are not suggested by any reasonable combination of the art of record, and otherwise comply with the statutes and regulations.

The Examiner rejected claim 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,380,991 to Valencia et al. (Office Action page 2).

The Examiner stated, "Valencia et al. teaches, for a paperless coupon redemption system and method, that the system and method includes a smart card and the terminal device (including card reader/writer) in communication with the card so as to write the data into the smart card." (Office Action page 3).

In contrast, claim 6, as amended, is patentable as it recites, *inter alia*, an interrelation including a processor in communication with a global computer network; and a program that receives a user selection, sends the received selection through the global computer network, subsequently receives, through the global computer network, coupon data corresponding to the selection, and causes the processor to write coupon data onto a smart card. No reasonable combination of the art of record, including Valencia et al., could have suggested this combination. Valencia et al. does, however, disclose that their "smart card 2, which is used to redeem the 'paperless electronic' coupons, can be purchased from a customer service center 64 which can be a stand-alone unit or can be located in a retail establishment. Alternatively, this card may be directly purchased from a cashier using the master reader/writer unit 62 provided adjacent to the cashier's checkout counter." (Valencia et al. col. 6, lines 51-59).

The Examiner rejected claims 1-5 and 7 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,710,886 to Christensen et al. in view of Valencia et al. (Office Action page 3).

Christensen et al. disclose "a SELLECTSOFT™ diskette may be created containing coupon information and program data for displaying and generating coupons." (Christensen et al. col. 5, lines 31-34). "Software on the diskette or CD-ROM may prompt a consumer to call a 1-800 number for a validation number or code. During the phone call,

telemarketing personnel may request consumer demographic and or identification information which may be entered into a centralized database. Once the software is validated, a consumer may print out selected coupons displayed on a Graphical User Interface (GUI)." (Christensen et al. Abstract).

In connection with the rejection under § 103 the Examiner cited Christensen et al. col. 8, line 43 - col. 9, line 8). "From instruction screen 5, the user may proceed to main menu screen 6. FIGS. 12-13 illustrate the further operation of the menu system. A consumer may click on a general category, and then click on more specific categories within that general category When a validation number has been previously entered, a user may proceed directly to instruction screen 5 or main menu screen 6 once the SELLECTSOFT™ software has been loaded." . . . A user may browse through screens of coupons within a category, or through various screens in various categories, as illustrated in FIGS. 12 and 13. In addition, a simple text search engine may be provided to enable the consumer to quickly find coupons of interest. A consumer may enter a word or portion of a word defining a brand name, category, or generic product name. The SELLECTSOFT™ software may then display a coupon or coupons." (Christensen et al. col. 8, line 43 - col. 9, line 8).

"Although discussed above in terms of diskette storage and mailing, it should be appreciated that other techniques for distribution and authorization may be utilized within the spirit and scope of the [Christensen et al.] invention. Coupon data may be transmitted via Internet or Internet World Wide Web (WWW) or through on-line services or on-line services providing access to the Internet. Similarly, dialup access may be provided via modem or the like." (Christensen et al. col. 16, lines 27 - 34).

"The package of coupon data may be distributed to consumer computers 802-804 via mailing of diskette as discussed above, or by other means (e.g, modem dialup, Internet, on-line service, ISDN, or other data transmission scheme)." (Christensen et al. col. 16, lines 44 - 54).

"Consumer computers 802-804 may receive demographic and/or identification data from respective consumers and communicate such data to SELLECTSOFT™ database computer 801 vial telemarketing data entry 806. Alternately, demographic and/or

identification data may be communicated verbally via a 1-800 call as discussed above. In response, to transmission of demographic and/or identification data, validation data may be transmitted to consumer computers 802-804 to allow for printing of coupons from the package of coupon information.” (Christensen et al. col. 16, lines 55 - 67).

Thus, Christensen et al. and Valencia et al. could not have suggested the interrelation of acts recited in claim 1, as amended, including transmitting to the user computer, via the global computer network, data referring to the product; receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product; subsequently, transmitting to the user computer, via the global computer network, coupon data; and writing the coupon data onto the smart card. No reasonable combination of the art of record, including Christensen et al., suggests this recited method with its interrelation of acts including the recited step transmitting to the user computer subsequent to the recited step of receiving.

Claim 2, as amended, is patentable as it recites, *inter alia*, a combination including transmitting to the user computer, via the global computer network, data referring to the product; receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product; and subsequently, transmitting to the user computer, via the global computer network, coupon data.

Claim 3, as amended, is patentable as it recites, *inter alia*, a combination transmitting to the user computer, via the global computer network, data referring to the product; receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product; and subsequently, transmitting to the user computer, via the global computer network, coupon data.

Claim 4, as amended, is patentable as it recites, *inter alia*, a combination transmitting to the user computer, via the global computer network, data corresponding to a coupon for a product; receiving from the user computer, via the global computer network, data indicating that the user desires to receive the coupon; subsequently, transmitting to the user computer, via the global computer network, data representative of the coupon.

Claim 5, as amended, is patentable as it recites, *inter alia*, a combination generating an input to the computer indicating a selection of a selected coupon from the

plurality of available downloadable coupons; and subsequently receiving, via the global computer network, data corresponding to the selected coupon, and causing the received data to be written to the smart card.

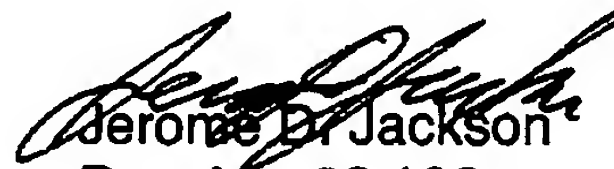
Claim 7, as amended, is patentable as it recites, *inter alia*, an interrelation of a first smart card reader/writer, in communication with the processor, capable of writing data to a smart card; and a program that receives a user selection, sends the received selection through the global computer network, and subsequently receives, through the global computer network, coupon data corresponding to the selection, and causes the processor to write coupon data onto a smart card.

In summary, rejections under § 103 cannot be sustained for two independent reasons. First, as shown above, even if a motivation for combination of the references existed and the references were combinable, there is no suggestion that the resulting combination could have suggested any of these claims. Second, there is no evidence that a motivation existed to combine Christensen et al. with Valencia et al. in this context, the content of Christensen et al. plus that of Valencia et al. not suggesting any of these claims.

If there are any other fees required for entry of this amendment, or for any other reason, please charge such fees to the undersigned attorney's Deposit Account No. 10-0077.

If the Examiner has any questions about this amendment, applicant's representative would appreciate discussing this amendment with the Examiner. Applicant's representative, Jerome Jackson, can be reached at 703-684-4840.

Respectfully submitted,


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DATED: 19 December 2005